APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/451,160	BOAL, STEVEN R.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 December 2002_ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-46_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-46_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _30 November 1999_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _20_ .	6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with amendment C on 20 December 2002 (Paper No. 22) have been fully considered but they are not persuasive. The arguments are discussed at para. 11 below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 28-43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims 26 and 27, does not reasonably provide enablement for claim 28. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Claim 28 contains the limitation "the user ID" in line 3, while claim 26 contains the limitation (lines 4-5) "without obtaining information sufficient to specifically identify the user", which reads on without obtaining a user ID. This rejection has arisen because claims 27-43 respectively are reintroductions of claims 2-21 as originally filed, while claim 26 is a reintroduction of claim 1 as amended on 27 March 2002 (amendment A, Paper No. 12).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 28-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation "The method" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "remote" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 et seq. recite the limitation "the user ID" in line 3. There is insufficient antecedent basis for this limitation in the claim. See para. 2 above.

Claim 42 recites the limitation "the plurality" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "said coupon" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as obvious over Mankoff in view of Sutherland and Schreiber et al.

9. Mankoff teaches (independent claim 24) providing a coupon to a consumer who clicks on a website ad (col. 5 lines 3-6 and col. 1 line 28), which reads on: associating a URL including a promotional code with a coupon (because "promotional code" is disclosed only to be an appendage to the URL, and that reads on the normal filename appendage of a URL); displaying the coupon to the user; and invoking the URL with a browser to thereby enable the user to redeem the coupon.

10. Mankoff does not teach disabling access to the URL by the user. sending substitute data ... for requested image data that is protected (col. 3 lines 27-33), which reads on disabling access to the URL by the user.

11. Applicant argues (p. 13, bottom two para.) that Schreiber et al. does not teach disabling access to the URL (para. 10 above). The reference teaches de-activating an image by replacing it with a non-active image. Since a link to a URL is practically always accessed through a click-on image (see para. 12 below), replacing that active image with an inactive one will prevent or disable access to the URL. Examiner believes that the reference explanation at col. 3 lines 27-33 is so strong that one of ordinary skill in the art would immediately understand that "sending substitute data ... for requested image data that is protected" means replacing a URL-active image (the requested image data that is protected) with an inactive image (the substitute data) means preventing or disabling access to a URL.

12. The references do not teach clicking on the displayed coupon (claim 25), but, for the sake of reinforcement, it would have been obvious to require clicking on the coupon when it is displayed.

13. Claims 1-6, 9-18, 22 and 23 are rejected under 35 U.S.C. 103(a) as obvious in view of the references given above, and further in view of Emaginet.

14. The references given above do not teach (claim 1) collecting information from a client system without obtaining information sufficient to specifically identify the user. Emaginet teaches collecting information from a client system, which reads on "a device of a client system", without obtaining information sufficient to specifically identify the user, which reads on "device information". Because it would protect user identity, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Emaginet to those of the references given above.

15. None of the references teach associating a device ID with the device information at the main server system. However, under the principles of inherency (MPEP § 21112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Emaginet does teach sending "offers" directly to the user's desktop, which reads on device, which would necessarily require identification (ID) of the

device. Since targeting requires sending offers consistent with the device information, the device information is necessarily associated with the device ID.

16. Emaginet also teaches selecting coupons according to the device information, and also therefore according to the device ID because the latter is associated with the former; and transmitting the selected coupons from the main server system to the client system.

17. Emaginet teaches claims 3 and 21, inherently, as noted in para. 10 above.

18. Emaginet teaches: (claim 4) printing a coupon at the client system.

19. Emaginet teaches claims 5 and 6 inherently. Since (claim 5) the selecting is done according to the device ID, the request must include the device ID. The device ID must be automatically included (claim 6) because there is no other way for the ID to be provided. (The user does not know the ID.)

20. Emaginet teaches (claims 14 and 15) transmitting advertising data, because a coupon reads on advertising data.

21. The references do not teach (claims 2 and 20) that the demographic characteristics include the user's postal zip code or state of residence. Because many products can best be targeted by geographic region (e.g., regional foods or resort services), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include postal zip code or state of residence in the collected demographic characteristics.

22. Emaginet does teach (claims 9 and 10) a GUI. The references do not teach displaying a flashing icon when a new coupon is available. Because they are both a convenience and a reward for users, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to display a flashing icon when a new coupon is available.

23. The references do not teach (claims 11-13, 22 and 23) encrypting or double encrypting the coupons. Because coupons are valuable and encryption discourages theft, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to encrypt or double encrypting the coupons, the double encryption used for the more valuable coupons.

24. Emaginet does not teach (claims 16-18) storing and encrypting a user detected events history file. Because purchase (detected) events are useful in targeted marketing and because encryption would help protect the user's privacy, it would have been obvious to one

of ordinary skill in the art, at the time of the invention, to store and encrypt a user detected events history file.

25. <u>Claims 7 and 8</u> are rejected under 35 U.S.C. 103(a) as obvious over the references given above and further in view of Phaal. <u>The references given above do not teach</u> <u>automatic</u> <u>request transmission at predetermined intervals</u>. <u>Phaal teaches</u> automatic request transmission at predetermined intervals (col. 3 lines 47-55 and col. 12 lines 42-45). <u>Because</u> Phaal teaches that the invention is a low cost mechanism to significantly enhance service (col. 2 lines 44-45), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teaching of Phaal to those of the references given above.

26. <u>Claim 26</u> is rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Emaginet.

27. <u>Emaginet teaches</u> a method for operating an electronic coupon distribution system comprising: collecting information from a client system, which reads on "a device of a client system", without obtaining information sufficient to specifically identify the user, which reads on "device information".

28. <u>Emaginet does not teach</u> <u>associating a device ID with the device information at the main</u> <u>server system</u>. However, under the principles of inherency (MPEP § 21112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference does teach sending "offers" directly to the user's desktop, which reads on device, which would necessarily require identification (ID) of the device. Since targeting requires sending offers consistent with the device information, the device information is necessarily associated with the device ID.

29. <u>Emaginet also teaches</u> selecting said coupon/coupons according to the device information, and also therefore according to the device ID because the latter is associated with the former; and transmitting the selected coupons from the main server system to the client system.

30. <u>Claim 44</u> is rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Emaginet.

31. <u>Emaginet teaches</u> an electronic coupon distribution system and method for its operation, the method comprising: collecting user information, comprising demographic characteristics, from a user of a client system, without obtaining information sufficient to specifically identify the user; selecting coupons based on the user's demographic characteristics; and transmitting the selected coupons from the main server system to the client system.

32. <u>Emaginet does not teach associating a user ID with the user information at the main server system</u>. However, under the principles of inherency (MPEP § 21112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that a user would have to re-register each time he or she visited the site if the user was not given a user ID at the time of their first visit. At very least, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide a user ID at the time of the user's first visit so as to avoid irritating and discouraging users from using the site. Such a user ID would have to be associated with the indicated user information, i.e., the registration information, so as to be useful.

33. <u>Claims 27-31, 34-43 and 45-46</u> are rejected under 35 U.S.C. 103(a) as obvious over Emaginet.

34. <u>Emaginet does not teach</u> (claims 27 and 45) <u>that the demographic characteristics include</u> the user's <u>postal zip code or state of residence</u>. <u>Because</u> many products can best be targeted by geographic region (e.g., regional foods or resort services), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include postal zip code or state of residence in the collected demographic characteristics.

35. <u>Emaginet does not teach</u> (claims 28 and 46) <u>associating the user ID with the client system</u>. Official Notice is taken that cookies were well known at the time of the invention. <u>Because</u> cookies are very convenient for the user, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to offer a cookie to the user so as to associate the user ID with the client system, thereby relieving the user of the need to enter the user ID with each visit to the main server system web site.

36. <u>Emaginet does teach</u> (claims 29-31) <u>printing a coupon</u> and that <u>requesting coupon selection from the client</u> is automatic upon accessing the website. As noted in the last paragraph, the <u>user ID is automatically included</u> when cookies are used.

37. <u>Emaginet does teach</u> (claims 34 and 35) <u>a GUI</u> and <u>displaying a flashing icon when a new coupon is available</u>. <u>Because</u> they are both a convenience and a reward for users, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to display a flashing icon when a new coupon is available.

38. <u>Emaginet does not teach</u> (claims 36-38) <u>encrypting or double encrypting the coupons</u>. <u>Because</u> coupons are valuable and encryption discourages theft, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to encrypt or double encrypting the coupons, the double encryption used for the more valuable coupons.

39. <u>Emaginet does teach</u> (claims 39 and 40) <u>transmitting advertising data</u>, because a coupon reads on advertising data.

40. <u>Emaginet does not teach</u> (claims 41-43) <u>storing and encrypting a user detected events history file</u>. <u>Because</u> purchase (detected) events are useful in targeted marketing and because encryption would help protect the user's privacy, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to store and encrypt a user detected events history file.

41. <u>Claims 32 and 33</u> are rejected under 35 U.S.C. 103(a) as obvious over Emaginet in view of Phaal. <u>Emaginet does not teach</u> <u>automatic request transmission at predetermined intervals</u>. <u>Phaal teaches</u> automatic request transmission at predetermined intervals (col. 3 lines 47-55 and col. 12 lines 42-45). <u>Because</u> Phaal teaches that the invention is a low cost mechanism to significantly enhance service (col. 2 lines 44-45), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teaching of Phaal to that of Emaginet.

Suggestion of Allowable Subject Matter

42. Key claim 24 is not allowable because Schreiber et al. teaches disabling access to a URL by de-activating its click-on image (para. 8-12 above). The reference does not teach or suggest disabling access to a URL by any means except de-activating its click-on image. Any other means known to applicant might be allowable.

43. Applicant is cautioned that allowance of any new amendment would be dependent on the results of a search of the prior art.

Conclusion

44. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

45. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.

47. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

48. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, and as a matter of economic necessity, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only

when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

49. Applicant may have after final arguments considered and amendments entered by filing a CPA or RCE as appropriate. It is the examiner's practice to search the specification of CPA/RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing a CPA or RCE will result in an indication of allowable matter.

50. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Examiner
Art Unit 3622

8 February 2003